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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,870	12/14/2001	Stephen Arthur Anderson	01-754	5982
7590 07/13/2004			EXAMINER	
Ogilvy Renault 1981 McGill College Avenue Suite 1600 Montreal, QC H3A2Y3 CANADA			BOYD, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/016,870	ANDERSON, STEPHEN ARTHUR	
	Examiner	Art Unit	
	Jennifer A Boyd	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed April 28, 2004, have been entered and have been carefully considered. Claim 1 is amended and claims 1 – 19 are pending. In view of Applicant's amendment to claim 1 requiring that the member positively "limits" flame propagation, the Examiner withdraws the 35 U.S.C. 112, 2nd paragraph rejection as set forth in paragraphs 3 - 4 of the previous Office Action dated February 2, 2004. Despite these advances, the invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1, 3 - 4, 8, 10, 12, 17 and 19 remain rejected under 35 U.S.C. 102(e) as being anticipated by Alhamad (US 6,349,774). The details of the rejection are found in paragraph 6 of the previous Office Action dated February 2, 2004. The rejection is maintained.

Claim 1 has been amended to require that the maximum void size "limits" flame propagation. Alhamad teaches the fire extinguishing capability of the metal net is based on the phenomenon that flame at the surface of a burning material cannot pass upwardly through the pores of the metal net (column 2, lines 33 – 36). Therefore, it is the position of the Examiner that the metal net of Alhamad "limits flame propagation".

Claim Rejections - 35 USC § 103

4. Claim 16 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Alhamad (US 6,349,774). The details of the rejection are found in paragraph 7 of the previous Office Action dated February 2, 2004. The rejection is maintained.

5. Claims 2, 7 – 8, 11, 13 – 14 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Alhamad (US 6,349,774) in view of Gooliak (US 2003/0060107 A1). The details of the rejection are found in paragraph 8 of the previous Office Action dated February 2, 2004. The rejection is maintained.

6. Claims 5 and 6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Alhamad (US 6,349,774) in view of Nevin (GB 2,266,051 A). The details of the rejection are found in paragraph 9 of the previous Office Action dated February 2, 2004. The rejection is maintained.

Response to Arguments

7. Applicant's arguments filed April 28, 2004 have been fully considered but they are not persuasive.

8. In response to Applicant's Arguments that Alhamad (US 6,349,774) teaches away from the fire retarding device of the present invention, the Examiner respectfully argues the contrary. Alhamad teaches an expandable metal product for use in extinguishing fires (Abstract). Alhamad

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teaches a three-dimensional expandable metal net having discontinuous slits in spaced apart lines parallel to each other but transverse to the longitudinal dimension of the sheet (column 2, lines 25 – 35). Alhamad teaches the fire extinguishing capability of the metal net is based on the phenomenon that flame at the surface of a burning material cannot pass upwardly through the pores of the metal net (column 2, lines 33 – 36). Alhamad teaches by controlling the extent of the stretching, it is possible to produce an expanded metal primatic net structure having the desired shape and size of eyes, and the desired expansion in area, depending on the use intended (column 6, lines 20 – 25). It should be noted that Alhamad teaches the critical feature claimed by the Applicant that the fire extinguishing capability of the metal net is due the pore size of the net, which limits flame propagation. Because Applicant never defines “maximum void size” with a numerical value, it is unclear what size would be a “maximum size”. It should be noted that the term “maximum” is a relative term. It is suggested by the Examiner for the Applicant to numerically define the “maximum size” of the void size in the claim limitations. Therefore, because the metal net of Alhamad limits flame propagation as required by Applicant, it is the position of the Examiner that the pores of the metal net are of Applicant’s “maximum size”. As for the requirement that the fire retarding device is used by superimposing the device on the hot casing before ignition, the Applicant must positively claim this requirement in the claim limitations by removing the language “adapted to”. Additionally, a recitation of the intended use of the fire retarding device as being “adapted for superposition on the hot casing” and “adapted to cover at least a portion of the hot casing” must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the

claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

9. In response to Applicant's Argument that void size and density are not result effective variables, the Examiner respectfully argues the contrary. The Examiner suggests optimizing the void size and density to create a device that is appropriately flexible while limiting flame propagation. See paragraph 7 of the previous Office Action dated February 2, 2004. It should be noted that the Examiner does not suggest increasing the void size beyond a predetermined maximum size. The Examiner acknowledges that the void size and density must be *optimized* and not necessarily *maximized*. The suggestion of optimization takes into account that too small of a void size and density may result in undesirable effects as well as too large of a void size and density; therefore, an optimum value must be determined through routine experimentation. If the Applicant is suggesting that the void size and density are not a matter of routine optimization, the Examiner suggests that the Applicant submit a 1.132 Declaration to support Applicant's claim of unexpected results.

10. In response to Applicant's Argument that Gooliak (US 2003/0060107) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gooliak teaches that insulation blankets and panels have been used in aircraft, such as the combustion, turbine and tailpipe sections of the turbine engines as fire walls (page 1, [0003]) while Alhamad teaches compositions of matter for stopping fires (Title). Therefore, Gooliak and Alhamad are useful in

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fire extinguishing applications while Gooliak is also noted as being useful for controlling heat energy.

11. In response to Applicant's Argument that the combination of Alhamad (US 6,349,774) and Nevin (GB 2,266,051) teaches away from the fire retarding device of the present invention, the Examiner respectfully argues the contrary. See Examiner Arguments above regarding the Alhamad reference. It should be noted that the Applicant does not argue the relevance or applicability of Nevin to the Alhamad reference. It is the position of the Examiner that Alhamad in view of Nevin meets the structural and/or chemical limitations and there is nothing on record to evidence that the prior art product could not function in the desired capacity of "limiting flame propagation of an ignited fluid". The burden is shifted upon the Applicant to evidence the contrary.

Conclusion

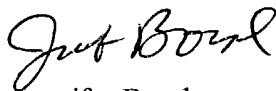
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Boyd

July 8, 2004


Ula C. Ruddock
Primary Examiner
Tech Center 1700